

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

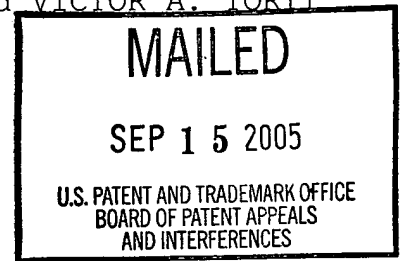
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY MATHUS, DANIEL J. SEGUIN and VICTOR A. TORTI

Appeal No. 2005-2350
Application No. 10/056,352

ON BRIEF



Before THOMAS, JERRY SMITH and SAADAT, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 22 through 36.

Representative claim 22 is reproduced below:

22. A test tube, comprising:

a tube body of unitary construction comprising an enclosed sidewall and an integral bottom that together define a tubular container having an open top, wherein said bottom has an exterior surface upon which machine readable data is encoded within an opaque coating deposited onto said exterior surface to uniquely identify said test tube.

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The following references are relied on by the examiner.

Mizobuchi et al. (Mizobuchi)	6,133,342	Oct. 17, 2000 (filed: Jan. 21, 1999)
Moh et al. (Moh)	6,165,594	Dec. 26, 2000 (filed: Jan. 15, 1998)
Wijnschenk et al. (Wijnschenk)	6,270,728 B1	Aug. 7, 2001 (Section 102(e) date: Jan. 29, 1999)

Claims 22 through 36 stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 22 through 32, the examiner relies upon Wijnschenk in view of Moh, with the addition of Mizobuchi as to claims 33 through 36.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief for appellants' positions, and to the answer for the examiner's positions.

OPINION

Generally for the reasons set forth by the examiner in the answer, we sustain the rejections of all claims on appeal under 35 U.S.C. § 103. As indicated at the bottom of page 2 of the principal brief on appeal, the appellants have indicated that claims 22 through 36 fall together. Arguments are presented in the brief only as to independent claim 22 with the patentability of independent claim 29 urged at page 5 to be dependent upon the arguments presented as to independent claim 22.

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No arguments are presented as well as to any dependent claim depending from either independent claim 22 or independent claim 29.

At the outset, we note that appellants have not argued against the combinability of Wijnschenk and Moh within 35 U.S.C. § 103 within the first stated rejection and the addition of Mizobuchi in the second stated rejection. Therefore, we construe the absence of the arguments thereto as conceding to the examiner's arguments that the applied prior art is properly combinable within 35 U.S.C. § 103.

We also note initially that the claimed tube body in claim 32 is stated to be of unitary construction and is said to comprise an enclosed sidewall and an integral bottom together defining a tubular container having an open top. The claim does not necessarily recite or require that the entire structure of the test tube be of one piece construction. The claim appears to require that the enclosed sidewall and a bottom be made integral thereto.

We turn first to the arguments in the reply brief where appellants urge that the proper reading of Wijnschenk reveals that the carrier part 6 is not the bottom of the container itself, but it is a separate item attached to the bottom of the

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tubular container of Wijnschenk's test tube. We disagree with this approach principally in view of the subsequent discussion but initially because the bottom of the carrier part 6 in Wijnschenk's figure 1 and 2a showings indicate that once this carrier part 6 is attached or otherwise affixed to the bottom dome shaped portion 3 of the test tube, the bottom surface area 7/9 becomes the bottom surface of the test tube itself. Moreover, the claim requires initially that the bottom be "integrated" with respect to the separately recited enclosed sidewalls. The term "integral" covers more than a unitary construction as is made clear in In re Morris, 127 F.3d 1048, 1055, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). Note also the cases cited therein. The use of the term integral in claim 22 on appeal clearly indicates that appellants interpret the claim to encompass multi-piece integrated structures anyway.

On the other hand, we also do not agree with appellants' two major arguments presented in the principal brief on appeal. As indicated earlier in this opinion, the outside or exterior bottom surface of the carrier part 6 of Wijnschenk becomes the bottom surface of the test tube to the extent it is recited in the independent claims on appeal. It is the exterior surface of the

integral bottom onto which is placed the coating, which is plainly evident to the artisan as argued by the examiner in the answer as well as from the following interpretations of the reference. We also do not agree with appellants' related argument that even assuming for the sake of argument that carrier part 6 may be fairly construed as a coating, it is submitted that the carrier part is not deposited onto the bottom surface of the tubular container 2.

There appears to us to be significant teachings not appreciated fully by the examiner and appellants in construing Wijnschenk's patent. The first appears to be set forth in the abstract; in column 1, line 59 through column 2, line 30 as well as the discussion at column 7, lines 5 through 21. These clearly indicate that there are prior art test tubes onto which is placed an opaque surface with/onto which is further placed machine readable indicia causing the indicia to be placed within the surface of the quoted material on the test tube by means of laser burning.

The second major teaching in Wijnschenk appears to begin at column 2, line 30 with respect to a separately attachable carrier part 6. In contrast to what appears an integral carrier part 6 shown in figures 1 and 2a, Wijnschenk appears to have a

separately attachable carrier part 16 in figure 2b. Note the teachings at column 2, lines 30 through 36; column 2, line 50 to column 3, line 9; the discussion beginning at line 10 of column 3; the separate discussion of the carrier part beginning at line 66 of column 3 through at least column 4, line 12 as well as the discussion at column 6, lines 4 through 63.

Among the significant teachings in these locations is that the embodiments in which a separate carrier part is actually manufactured, it may be separately glued or otherwise stuck or pressed onto the tubular container of the test tube itself. It also may be molded separately and then injection molded or otherwise molded into a unitary structure along with the tubular nature of the test tube itself. To the artisan, these teachings would have clearly indicated a unitary structure in which there is an integral bottom. In all embodiments the integral bottom is shown and taught to be a flat bottomed portion of an overall test tube structure like that claimed. Of particular note additionally is the teaching with respect to figure 7 beginning at column 7, line 22 through at least line 4 of column 8. The discussion at the bottom of column 7 beginning at line 64 plainly

indicates that the separate carrier part 112 in figure 7 may be directly injected molded onto the bottom 110 of the test tube 100 as well.

Although we recognize that the teachings in part, in the paragraph bridging columns 2 and 3 of Wijnschenk, indicate that the laser may burn the machine readable code into the actual material comprising structure of the carrier part itself, the additional teachings at column 7, lines 5 through 20 which indicate that a separate carrier part may utilize a separate carrier surface. In any event since appellants have not argued the combinability and teachings of Moh, that reference provides additional teachings of the use of a separate coating that may be otherwise deposited in some product-by-process manner onto an exterior surface of glass-type articles consistent with the test tubes claimed. Finally, we observe that the flat plate 107 at the bottom of figure 7 is a separately identifiable part from the carrier part 110 which the artisan would clearly interpret as a separate coating that is otherwise deposited on the bottom surface of the carrier part 112 in that figure. It is within this flat plate 107 that the machine readable codes are burned in by laser action. All these teachings are in addition to the discussion noted earlier beginning at the bottom of column

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1 where at least some measure of prior art test tubes are provided onto which the optical coating material is directly applied as a substantially opaque surface to the bottom of the test tube.

Lastly, we address appellants' arguments beginning at the bottom of page 4 of the principal brief on appeal relating to the prosecution of the parent application from which this is a continuation, further noting that the prior application was allowed and issued. The examiner points out at pages 10 and 11 of the answer the present claims on appeal are substantially broader than those which have been allowed in its parent application. Because of this, the present claims may be made subject to an obviousness-type double patenting rejection and the required filing of a terminal disclaimer to avoid a time wise extension of subject matter originally filed but allowed in a broader claim presented subsequently. During examination of subsequent applications the Director is generally permitted to cause subsequent applications to be examined to avoid any mistakes. Furthermore, two wrongs do not make a right. In re Riddle, 438 F.2d 618, 620, 169 USPQ 45, 47 (CCPA 1971); and Fessenden v. Coe, 99 F.2d 426, 432, 38 USPQ 516, 521 (D.C. Cir. 1938).

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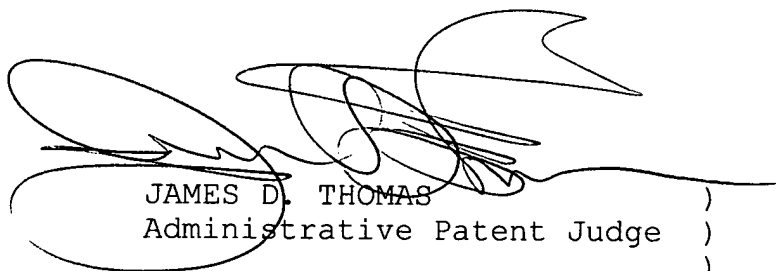
Lastly, with respect to the case law precedent cited at the bottom of page 5 of the principal brief on appeal, it is noted that identical issues are not present in this appeal. As noted earlier by the examiner, the claims in the present appeal are substantially broader than those presented and allowed and issued in the parent application. Even for situations in which the patent examiner may attempt to invoke the doctrine of Res Judicata, it does not apply because the issues are different, namely the nature and scope of the claimed subject matter is different. All this presents a new record for consideration and new issues as a result. Note In re Russell, 439 F.2d 1228, 1230, 169 USPQ 426 (CCPA 1971) and In re Herr, 377 F.2d 610, 611, 153 USPQ 548, 549 (CCPA 1967).


In view of the foregoing, the decision of the examiner rejecting all claims on appeal under 35 U.S.C. § 103 is affirmed.


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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED


JAMES D. THOMAS
Administrative Patent Judge


JERRY SMITH
Administrative Patent Judge


MAHSHID D. SAADAT
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

JDT/hh

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